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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,629	12/07/2000	Steven M. French	AUS920000812US1	1076

35525 7590 05/20/2010

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ART UNIT	PAPER NUMBER
2444	

NOTIFICATION DATE	DELIVERY MODE
05/20/2010	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. FRENCH and LORIN E. ULLMANN

Appeal 2008-005206
Application 09/731,629
Technology Center 2400

Decided: May 18, 2010

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-9 and 11-27. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and system for concurrently booting a list of client computers (Spec. 1).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method of generating a list of target devices to be configured in communication with a server comprising:

creating a first list of target devices to be configured;

identifying at least one addressed target device having an associated network address;

modifying the first list of target devices using the addressed target device; and

generating a modified list of target devices to be configured, wherein the target devices are to be remotely booted by the server and wherein the target devices are persistently and concurrently in communication with the server by means of a network.

The References

The Examiner relies on the following references as evidence:

Beelitz	US 6,182,275 B1	Jan. 30, 2001 (filed Jan. 26, 1998)

Cohn	US 6,411,684 B1	Jun. 25, 2002 (filed Apr. 7, 1998)

The Rejections

The following rejections are before us for review:[1]

Claims 1-9 and 11-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Beelitz and Cohn.

II. ISSUE

Has the Examiner erred in finding that the combination of Beelitz and Cohn teaches or fairly suggests "generating a modified list of target devices to be configured, wherein the target devices are . . . persistently and concurrently in communication with the server by means of a network," as recited in independent claim 1?

III. PRINCIPLES OF LAW

Obviousness

"Obviousness is a question of law based on underlying findings of fact." *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the

[1] The Examiner rejected claims 1, 13, and 23 under 35 U.S.C. § 112, first paragraph in the Final Rejection mailed on Sep. 26, 2006. However, in the Examiner Answer, filed on July 18, 2007, no 35 U.S.C. § 112, first paragraph rejection of claims 1, 13, and 23 has been applied. Thus, we deem that the Examiner withdrew the rejection.

differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citation omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Beelitz

1. Beelitz discloses a system for remotely configuring a target computer being ordered by generating a list of operating system types available for the computer and installed the operating system after the user selects one (col. 7, l. 23-col. 8, l. 67).

2. Beelitz only mentions one targeted device is initially booted for down loading and installing the operation system via internet (col. 15, ll. 1-7), but does not teach installing operating system concurrently on a list of targeted computer since the Beelitz's build-to-order system is used by one user (Abs.).

Cohn

3. Cohn discloses a network hub system, each hub may be implemented utilizing a variety of hardware platforms and communicates with each other through the network, can provide status or user profile

updates or advertisements to the hubs in the network (Abs.; col. 10, ll. 33-50; col. 12, ll. 20-28; col. 34, ll. 7-26).

V. ANALYSIS

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to the Appellants' Brief to show error in the proffered reasoned conclusion. *Id.*

The Common Feature in Claims

Independent claim 1, recites, *inter alia,* "generating a modified list of target devices to be configured, wherein the target devices are . . . persistently and concurrently in communication with the server by means of a network." Independent claims 13 and 23, contain these similar limitations.

35 U.S.C. § 103(a) rejections

With respect to independent claim 1, the Appellants contend that Beelitz does not disclose the argued limitations but "teaches only loading and installing the operating system onto the targeted computer system, prior

to disconnecting the network connection to enable the newly built-to-order computer to ship to a business or individual." (App. Br. 14, Reply Br. 4).

The Examiner states that Beelitz teaches all limitation but the argued limitation. Cohn teaches the argued limitation "*due to the constant communication between the hubs, and using a real time communication protocol to input orders*" (Ans. 10 emphasis original).

We disagree with the Examiner's reading of references. We find that the paragraph of the Beelitz reference relied upon by the Examiner only discusses that one computer being ordered is configured by a list of operating systems selected by a user (FF 1). Beelitz does not mention a list of target devices (only one target computer), nor the target devices are persistently and concurrently in communication with the server by the network (FF 2).

We next look to the teachings of Cohn. We find that the network hub system of Cohn only teaches that there is constant communication with hubs (FF 3) but we find no teachings for booting a list of target device while the target devices are persistently and concurrently communicated with the server. Further, the Examiner only provided a limited discussion of the teachings of the Cohn reference (Ans. 3 and 10). We find this limited discussion to be not sufficient to teach or fairly suggest the specific limitations recited in claim 1. Thus, we will not speculate whether which specific teachings or extrapolation of teachings read on the claimed limitations. We, therefore, find the Examiner's position is untenable.

Because we agree with at least one of the Appellants' contentions, we find that the Examiner has not made a requisite showing of obviousness as required to teach or fairly suggest the invention as recited in claim 1 by the combined teachings of Beelitz and Cohn. The independent claims 13 and 23 contain the similar limitations to those found in independent claim 1. The Appellants present similar arguments as set forth with respect to independent claim 1 in response to the rejections of independent claims 13 and 23 (App. Br. 13-14).

The rejection of the dependent claims 2-9, 11-12, 14-22, and 24-27 contains the same deficiency. The Appellants, thus, have demonstrated error in the Examiner's proffered conclusion for obviousness of the subject matter of claims 1-9 and 11-27.

VI. CONCLUSION

We conclude that the Examiner erred in finding that the combination of Beelitz and Cohn teaches or fairly suggests "generating a modified list of target devices to be configured, wherein the target devices are . . . persistently and concurrently in communication with the server by means of a network," as recited in independent claim 1.

VII. ORDER

We reverse the obviousness rejections of claims 1-9 and 11-27 under 35 U.S.C. § 103(a).

REVERSED

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